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June 13, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2835 - Examiner Chervinsky, Boris Leo

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/807,036
File Date: 5/13/05
Inventor: Thomas Aisenbrey
Examiner: Chervinsky, Boris Leo
Art Unit: 2835
Title: Low Cost Thermal Management Device or Heat Sink
Manufactured from Conductive Loaded Resin-Based Materials

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated May 13, 2005. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on June 13, 2005.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: June 13, 2005

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-46, drawn to a cooling device for and electrical system and method of cooling, classified in class 361, subclass 704, and

II - Claims 47-51, drawn to a method of forming, classified in class 264, subclass 478+, and

III – Claims 52-64, drawing to light/heat sink device, classified in class 362, subclass 382+.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-46, drawn to a cooling device classified in Class 361, subclass 704. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different

product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of forming "a method", and that the product claims are directed to "a heat sink device", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 264/478+ and product class/subclass 361/704, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case the product as claimed can be made by another and materially different process such as machining" is speculative and has nothing to do with the Claims as presented in this patent application.

In addition, the Examiner states that Inventions I and III are related as combination and subcombination, and gives as the reasons for distinctness that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. 806.05(c)). However, upon reading the Invention III Claims against the Claims of Invention I, it can be seen that Invention III is drawn to "a combined light and heat sink device", while Invention I is drawn to "a heat sink device". As such, the field of search must necessarily cover both the Group I class/subclass 361/704 and the Group III class/subclass 362/382+, in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group III

inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case, invention of Group I and III has separate utility such as heat sinking and lighting" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'SBA', is written over the typed name.

Stephen B. Ackerman, Reg. No. 37,761